

### **REMARKS**

No claims have been added or cancelled. Claims 13, 14, 16, and 17 have been amended. With entry of this amendment, claims 13-18 will be pending.

Support for the amendment to claim 13 may be found at least at paragraphs [0012]-[0015], [0025], [0031], and [0041] of the specification as originally filed.

Support for the amendment to claim 14 may be found at least at paragraphs [0033] and [0035] of the specification as originally filed.

Support for the amendment to claim 16 may be found at least at paragraphs [0043], [0002], and [0067] of the specification as originally filed.

Support for the amendment to claim 17 may be found at least at paragraphs [0043], [0002], and [0069] of the specification as originally filed.

No new matter has been added. Entry of these amendments is respectfully requested.

### **Priority**

All requirements under 35 U.S.C. § 371 were completed on November 14, 2005, and the priority claim was acknowledged on the notice of acceptance of application dated May 8, 2006. Applicants have amended the specification to recite the priority claim. No new matter has been added. Applicants respectfully request entry of the amendment.

### **Objections to the Specification**

The specification stands objected to for reciting the liquid phase being aqueous and having mineral particles (titanium dioxide) grafted with hydrophobic groups, such as perfluoroalkyl phosphates, and then reciting the liquid phase being oily and having mineral particles (titanium dioxide) grafted with lipophobic groups, such as perfluoroalkyl phosphates. The Examiner is unclear as to how the titanium dioxide treated with perfluoroalkyl phosphate groups is considered to be both hydrophobic and lipophobic. Applicants respectfully submit that it is well known to those of skill in the art that perfluoroalkyl phosphate treatment may impart

either hydrophobicity or lipophobicity or both. Perfluoroalkyl phosphate has both lipophobic and hydrophobic properties. Applicants respectfully request withdrawal of the objection.

The Examiner has suggested that headings be added to the specification to make the specification more clear and organized. The specification has been amended to incorporate headings. These amendments add no new matter. Applicants respectfully request entry of the amendments and withdrawal of the objection.

#### **Claim Rejections under 35 U.S.C. § 112**

Claims 13-18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter.

With respect to claim 13, the Examiner asserts that it is unclear how the cosmetic composition can be in a powder form since there is a liquid phase in the composition. Applicants respectfully submit that the liquid phase is just one component of the composition. As amended, claim 13 recites that the “liquid phase is encapsulated in or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder, and wherein the cosmetic composition is in a powder form that is transformed into a cream upon application.”

The Examiner further asserts that it is unclear how the cosmetic composition is transformed into a cream upon application. Applicants draw the Examiner's attention to paragraphs [0025] and [0026] of the specification: the liquid phase “can be immobilized on a solid carrier (adsorbed or deposited on this carrier) or encapsulated in a solid carrier, with this solid carrier making up in whole or in part powder (B). Thus, according to this variation, the solid carrier can for example be dispersed within powder (B), or powder (B) in its entirety serves as a carrier for phase (A).” Further, “. . . stage (E) of the process of the invention consists of releasing the phase (A) immobilized in the solid carrier, subjecting powder (B) that contains phase (A) in an immobilized form to a mechanical stress (this mechanical stress could, in particular, be performed by applying powder (B) integrating phase (A) to the skin's surface)” (paragraph [0025]). As such, the “. . . powder (B) that contains phase (A) can be considered a solid precursor of the cream composition that will be obtained in the end” (paragraph [0025]).

The Examiner also asserts that it is unclear if the solid recited in lines 4-5 is the same solid recited in line 2. Applicants have amended claim 13 to clarify that the powder includes a solid carrier, and the “liquid phase is encapsulated in or immobilized on the surface of a solid carrier”.

With respect to claims 16 and 17, the Examiner asserts that it is unclear how the composition is transformed upon application. Applicants have amended claims 16 and 17 to clarify that the composition transformed from a powder form into a water-based (or oil-based) composition with the texture of a cream upon application. As described above, paragraph [0025] describes how the composition changes texture upon application of mechanical stress, for example, upon application of the composition to the skin.

Claims 13, 16, and 17 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being incomplete for omitting essential steps. Applicants respectfully submit that claims 13, 16, and 17 are directed to a composition, not a method. Applicants further submit that upon entry of amendments to claims 16 and 17 described above, claims 13, 16, and 17 all recite that the composition is transformed from a powder form into a cream upon application. Applicants submit that the claims are complete with no steps omitted.

Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested.

#### **Claim Rejections under 35 U.S.C. § 103**

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,645,903 to Tanaka et al. (“Tanaka”) in view of U.S. Patent No. 5,063,050 to Verdon et al. (“Verdon”).

Claims 13, 15, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. U.S. 2002/0012682 to Kashimoto (“Kashimoto”) in view of U.S. Patent No. 6,548,454 to Yamamoto (“Yamamoto”) and Verdon.

Claims 14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Verdon and further in view of U.S. Patent No. 5,622,693 to Funatsu ("Funatsu").

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashimoto in view of Yamamoto and further in view of Verdon and further in view U.S. Patent No. 5,023,065 to Ohno ("Ohno").

### **Independent Claim 13**

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Verdon.

Tanaka discloses a composition that "comprises (a) a water-soluble solidifying agent selected from agar and gelatin, (b) an oil component and (c) water, and optionally, (d) a powder or (e) a water-soluble adhesive" and a container for "an aqueous-type solid cosmetic composition . . . having a water-absorbing material secured to a receptacle of the container" Abstract. Tanaka discloses "oil-in-water type emulsions." Column 4, lines 1-3.

Verdon discloses "powdered cosmetic preparations prepared in the form of compressed tablets" and "pressed cosmetic powders without the use of an aqueous medium or a molding pan." Column 1, lines 6-8, 63-65.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established for the reasons provided below.

First, Applicants respectfully submit that one skilled in the art would not be motivated to combine Tanaka and Verdon. Tanaka relates to an oil-in-water emulsion composition, and Verdon relates to a pressed powder composition. In other words, Tanaka and Verdon are directed to two different composition types and are not combinable.

Even assuming, *arguendo*, that the references are combinable, Tanaka and Verdon still do not teach the subject matter of amended independent claim 13. Tanaka does not teach or suggest, among other things, a cosmetic composition in a powder form that is transformed into a cream upon application. Furthermore, Tanaka does not teach or suggest liquid phase

encapsulated in or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder. Rather, Tanaka discloses an oil-in-water composition with “water oozing out from the aqueous-type solid composition.” Column 5, lines 51-52. This is different from Applicants’ claim 13. The Examiner concedes that Tanaka does not disclose a cosmetic composition in powder form that is transformed into a cream upon application. Office action at page 7, lines 9-10. Verdon fails to cure the deficiencies of Tanaka. Verdon does not teach or suggest, among other things, a liquid phase encapsulated in or immobilized on the surface of a solid carrier. Additionally, Verdon does not teach or suggest a gelling agent for a liquid phase, nor particles having surface properties that give the particles a low affinity for the liquid phase. Instead, Verdon teaches pressed powder products that provide a creamy texture, a moisturizing effect, and light sheer coverage. Column 3, lines 45-47. The compositions of Verdon are pressed powders with a firm consistency. Column 3, lines 20-26. Accordingly, Applicants respectfully submit that Tanaka and Verdon, taken alone or in combination, do not teach or suggest all the subject matter of amended independent claim 13.

Claims 13 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashimoto in view of Yamamoto and Verdon.

Kashimoto discloses “a pressed powder cosmetic composition, which comprises . . . a water-repellent and oil-repellent powder selected from the group consisting of fluorine resin powders and a powder having a surface treated with a fluorine compound, a film-forming polymer . . . and an oil. Paragraphs [0010]-[0013].

Yamamoto discloses:

a rolling apparatus comprising a movable member which can undergo rotary or linear motion, a support member carrying said movable member, rolling elements disposed between the movable member and the support member which rolls with the movement of the movable member, and a lubricant composition disposed between the movable member on which the rolling elements roll and the support member, characterized in that the lubricant composition is a mixture of a thickening agent containing a powder of at least one lamellar mineral selected from the group consisting of mica-based mineral, vermiculite-based mineral and montmorillonite-based mineral and a base oil composed of liquid fluorinated polymer oil. Column 4, lines 46-59.

According to Yamamoto, a “lubricant composition to be used in the rolling apparatus . . . comprises a thickening agent containing a lamellar mineral powder and a base oil composed of liquid fluorinated polymer oil.” Column 8, lines 36-40.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established for the reasons provided below.

Applicants respectfully submit that one skilled in the art would not be motivated to combine Kashimoto, Yamamoto, and Verdon. Kashimoto relates to pressed powder compositions, Yamamoto relates to a rolling apparatus with a prolonged torque life that can undergo rotary or linear motion, and Verdon relates to tableted powder cosmetics. These references are directed to unrelated fields and compositions with no common purpose. These references are not combinable.

Even assuming, *arguendo*, that these references are combinable, Kashimoto, Yamamoto, and Verdon still do not teach or suggest the subject matter of amended independent claim 13. Kashimoto does not teach or suggest a composition in powder form that transforms into a cream upon application. The Examiner concedes this deficiency: “Kashimoto fails to expressly disclose the cosmetic composition transforming from a powder into cream.” Office action at page 9, lines 7-9. Rather, Kashimoto discloses a “pressed powder cosmetic composition which has smooth and moisturized touch feeling.” Paragraph [0008]. Further, Kashimoto does not teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. In fact, encapsulation or immobilization of a liquid phase on the surface of a solid is not disclosed anywhere in Kashimoto. In contrast to Applicant’s claim 13, Kashimoto discloses a water-repellent and oil-repellent powder and a film-forming polymer. Paragraphs [0011]-[0012]. Furthermore, Kashimoto does not teach or suggest a gelling agent for a liquid phase. Rather, Kashimoto discloses a composition comprising a film-forming polymer having a modulus of elasticity. Claim 1. The Examiner asserts that the fluorine-treated mica of Kashimoto (Table 1) is a gelling agent. Applicants respectfully submit that the fluorine-treated mica of Kashimoto is used as a particle and that the composition includes no gelling agent. Applicants have claimed a cosmetic composition comprising a liquid phase and a powder, the powder comprising a gelling agent for the liquid phase and mineral or organic particles having surface properties that give the

particles a low affinity for the liquid phase, wherein the liquid phase is encapsulated in or immobilized on the surface of a solid carrier, the solid carrier being dispersed in the powder or a component of the powder, and wherein the cosmetic composition is in a powder form that is transformed into a cream upon application. Applicants respectfully submit that it is improper for the Examiner to use the same component of Kashimoto (fluorine-treated mica) to read on multiple components of the Applicant's composition (particles and gelling agent).

Yamamoto does not cure the deficiencies of Kashimoto. Specifically, Yamamoto does not teach or suggest a cosmetic composition in a powder form that is transformed into a cream upon application. Rather, Yamamoto discloses a lubricant composition comprising a thickening agent and a base oil. Column 8, lines 36-40. Additionally, Yamamoto does not teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. Rather, Yamamoto discloses a lubricant composition that is a mixture of a thickening agent which is a fluoro-mica-based lamellar mineral particle or a mixture of said lamellar mineral particle and a solid fluoropolymer particle, and a base oil comprising a liquid fluorinated polymer oil. Claim 1.

Verdon also fails to cure the deficiencies of Kashimoto and Yamamoto. Specifically, Verdon does not teach or suggest a gelling agent for the liquid phase, nor does Verdon teach or suggest a liquid phase encapsulated in or immobilized on the surface of a solid carrier. In contrast, Verdon discloses a pressed cosmetic powder composition formed from talc, a powdered lubricant, a powdered sorbent agent, and a liquid binder. Column 2, lines 9-17. Verdon discloses "pressed powder products, (that) when applied to the skin, provide a creamy texture, a moisturizing effect and a light sheer coverage." Column 3, lines 45-47. The composition of Verdon does not transform into a cream upon application. Hence, Kashimoto, Yamamoto and Verdon, taken separately or combined, do not teach or suggest all the subject matter of claim 13.

Accordingly, independent claim 13 is allowable. Reconsideration and allowance of claim 13 are respectfully requested.

#### **Dependent Claims 14-18**

Claims 14-18 depend from allowable independent claim 13, and therefore, are allowable. These claims may contain additional patentable subject matter for reasons not discussed herein.

### CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and allowance of claims 13-18. The Examiner is invited to contact the undersigned by telephone at the Examiner's convenience should any issues remain.

Respectfully submitted,

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